

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

TOSHIKI MORI, et al.

Serial No. 09/487,265

Group Art Unit: 3623

Confirmation No. 2955

Filed: January 19, 2000

Examiner: A. K. Robinson-Boyce

For: MESSAGE PROCESSING APPARATUS, MESSAGE PROCESSING SYSTEM,
MESSAGE MANAGING METHOD, AND STORAGE MEDIUM STORING MESSAGE
MANAGEMENT PROGRAM

REPLY BRIEF

MAILSTOP: APPEAL BRIEF PATENTS

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer mailed November 3, 2006, the following reply is made.

The Examiner has focused on claim 1 and lumped all other claims, including the dependent claims, together with claim 1 (see Answer, page 16). This has been done even though each of the claims has been argued separately and different distinctions argued therefore. That is, the Examiner did not address all of the arguments made by the applicant. Reversal of the rejection of claims 2-23 for a failure to present an answer thereabout is requested.

On page 11 the Examiner noted that the applicants argued that there is no suggestion that the teachings of Oliver and Nakaoka be combined and there that there is no suggestion for modifications to the prior art needed to accomplish the inventions. In arguing against these propositions the Examiner stated:

However, these references are properly combined since both are related to project/task management, where task data related to a project is managed by project management software.
(See Answer, page 11)

In making this statement the Examiner is reinforcing what the applicants have been arguing. The prior art is about assessing the performance of a project whose tasks have been scheduled and performed enough to assess performance (Oliver) and about worker support during the execution of a task (Nakaoka). In contrast, the present inventions are about the scheduling of a job where there is a negotiation with the workers over the completion date of the job. For example, claim 1 recites "an entry space for entering a completion date offer indicating a completion date ... receiving each completion date offer ... display the completion date offers of the receivers together with a decision result with respect to the completion date offers of the receivers". This is a situation where a worker has not started a task (whereas in Nakaoka the worker has started) and for which performance cannot yet be assessed (whereas in Oliver performance can be assessed), but has made an offer to complete a task (a scheduled completion date) and a decision has been made about the offer (accept or reject), thus resulting in a negotiation over the completion of a job.

Once again it is asserted that there is no motivation to combine Oliver and Nakaoka in order to solve a scheduling problem or to improve a scheduling system to accomplish a scheduling negotiation as in the claimed inventions.

Once again it is submitted that there is no suggestion as to how to change or the modifications needed to the project performance assessment system of Oliver and the task support system of Nakaoka to make them into a task scheduling system that involves a completion date offer for a job and a decision about that offer.

Once again it is submitted that there is no suggestion within the prior art of the desirability of such modifications. In fact, because the Oliver and Nakaoka are about much different phases (performance and support) than the present invention (negotiated scheduling), they teach away from the desirability of any such modifications.

On pages 11 and 12, the Examiner asserted that the claims do not disclose task scheduling.

The Examiners bases this assertion on the allegation:

In this case, the tasks have not yet been scheduled, but only indicated as needing to be completed, while a receiver makes an offer to complete the job, however, the job is not yet actually scheduled until the decision result with respect to the completion date offers of the receivers is further processed.
(See Answer, page 12, underlining emphasis supplied)

The present inventions, for example claim 1, call for "receiving each completion date offer" and "display the completion date offers of the receivers together with a decision result with respect to the completion date offers of the receivers". That is, the decision (accepted/rejected) about the offer by the worker is displayed. One wonders whether a worker who sees the display of an accepted offer made by that worker considers the completion date for that job to have been scheduled. It is submitted that the worker who sees such a display would consider the completion date to have been set or scheduled. Consistent with normal expectations in such a situation, one who sees that an offer they have made has been accepted is expected to fulfill the accepted offer. One also wonders whether a boss who accepts the offer would consider the completion date to have been scheduled. Again, normal expectations are that the boss would have considered the completion date scheduled. One further wonders whether the boss would expect the job for which an offered completion date has been accepted to not be completed by the accepted completion date. It is submitted that the boss would expect the job to be completed on the offered completion date. It is further submitted that both a worker and a boss would expect the job to be completed by the accepted completion date offer.

The Examiner appears to be asking the Board to believe something that is contrary to common expectations.

The Board is requested to dismiss the unreasonable rational being raised by the Examiner as to why the claims are not about task scheduling.

It is submitted that making a job completion offer about which a decision is made is about negotiated task scheduling, contrary to the Examiners allegation.

On pages 12 and 13 the Examiner addresses the applicants arguments concerning hindsight by merely asserting that the prior art is analogous art. It appears that the Examiner is mixing the legal concepts of hindsight and analogous art. If indeed Oliver and Nakaoka are in an analogous art, which is not being conceded by the applicants, the Examiner can, using improper hindsight, impermissibly pick and chose among parts of references to thereby misinterpret them.

It is submitted, as discussed in the Brief, that the Examiner is using hindsight in rejecting the claims.

On pages 13 and 14 the Examiner dismisses the assertion that the invention improves a managers job of scheduling workers. Such results and novel properties are part of the evidence of the invention as a whole that is considered in weighing whether a claim is patentable. (See In

re Wright, 6 USPQ 2d 1959, 1962 (Fed. Cir. 1988) (overruled in part by In re Dillon, 16 USPQ 2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991)), and Panduit Corp. v. Dennison Mfg. Co., 1 USPQ 2d 1593, 1595-96 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987)).

On pages 14 and 15, the Examiner acknowledged the applicants' arguments concerning the failure of the prior art to teach a decision result with respect to completion date offers that are displayed:

Applicant proceeds to argue that the prior art does not disclose the limitations of independent claim 1, which is to display a decision result with respect to the completion date offers of the receivers' which is displayed 'together' with the job completion date offers.

(See Action, page 14)

However, the Examiner responds to applicants' argument by asserting that the display of an earned value by Oliver is a ratio, that "Oliver's 'ratio' is analogous to the 'ratio' of the claimed invention", and that the display of the ratio with expected results "represents the decision result and offers being displayed together since Oliver's results are graphically displayed" (Answer page 15).

It appears that the Examiner is reading the ratio features of the dependent claims into claim 1. Claim 1 does not recite a ratio. Rather, claim 1 recites "a completion date offer indicating a completion date" that is displayed "together with a decision result with respect to the completion date offers of the receivers". That is, a date and a decision about that date are displayed not some graphically based earned value comparison.

The Examiner, in asserting a rational for the obviousness of claim 1 over Oliver, has had to go through several levels of interpretation of Oliver (earned value interpreted as a ratio, the ratio interpreted as analogous to a ratio not claimed in claim 1, a comparison of accomplished earned value results to planned results interpreted as a decision result, and a graphical display of the comparison of earned value and planned results interpreted as the decision result and offers being displayed together. This is a misinterpretation of Oliver that is clearly being done in hindsight. A rational with such a contorted multilevel interpretation of a prior art reference is not reasonable and should be discussed.

For the above-discussed reasons, the Board is again urged to reverse the rejections made by the Examiner.

Respectfully submitted,

STAAS & HALSEY LLP

Date: _____

By: /J. Randall Beckers/
J. Randall Beckers
Registration No. 30,358

1201 New York Ave, N.W., Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501